

REMARKS

An Office Action was issued in the subject application on July 13, 2004, in which:
claims 1, 8, 11–13, and 15–18 were rejected under 35 U.S.C. § 102;
claims 3–7, 9, 14, and 20 were rejected under 35 U.S.C. § 103; and
claims 2, 10, and 19 were objected to but deemed allowable.

Summarizing this Amendment, claims 2, 10, and 19 have been amended to overcome the objections thereof. Claims 1–20 remain in the application. Reconsideration and reexamination of the subject application in view of the amendments and the following remarks are respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1, 8, 11–13, and 15–18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,012,866 to Podosek.

Applicant traverses these rejections.

Requirements for Anticipation

The Federal Circuit stated in *W.L. Gore & Associates v. Garlock, Inc.* [721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)] that an anticipation rejection under 35 U.S.C. § 102 “requires the disclosure of a single prior art reference of each element of the claim under consideration.” It is not enough, however, that the prior art reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, “[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim” [*Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)]. Likewise, the Court of Customs and Patent Appeals (CCPA) stated in *In re Wilder* [429 F.2d 447, 166 USPQ 545, 548 (C.C.P.A. 1976)]:

Simply stated, a prior publication or patent description will be considered as anticipatory when its disclosure is at once specific and enabling with regard to the particular subject matter at issue. In effect, a prima facie case is made out whenever a reference is shown to contain a disclosure which is specific as to every critical element of the appealed claims.

In other words, a prima facie case of anticipation is established when the Patent Office provides:

- a) a single reference
- b) that teaches or enables

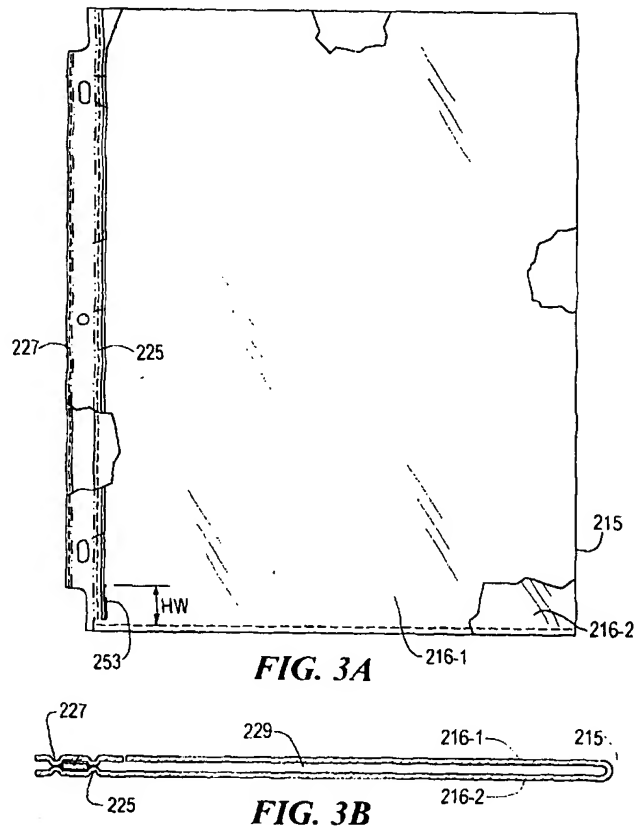
- c) each of the claimed elements (arranged as in the claim)
- d) expressly or inherently
- e) as interpreted by one of ordinary skill in the art.

If any one of these elements is not present, the prima facie case of anticipation is not established. In the instant case, it is respectfully submitted that the Podosek patent fails to meet these requirements.

The Cited Reference

U.S. Patent No. 6,012,866 to Podosek shows and describes a conventional sheet protector. The Podosek patent is characterized in the Office Action as follows:

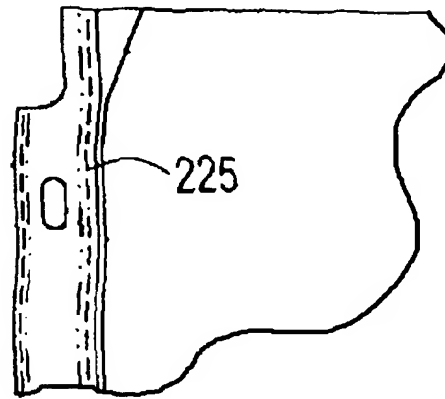
Podosek discloses a sheet protector comprising a sheet of material folded about a fold line (215) to form a front panel (216-1) and a back panel (216-2) each having a top edge, a bottom edge, a pair of side edges (as seen in figures 3A, B), the fold line defining one of the pairs of side edges of the panels; the panels being welded together at a bottom weld line (223); an outer weld line (227) located opposite the fold line; an inner weld line (252) located in spaced relationship from the outer weld line defining a margin (as seen in figure 3B); the fold line, the bottom weld line and the inner line defining between the panels a pocket (229) with an opening along the top edges of the panels; the inner weld line extending to a location (HW) that is short of the top edges of the panels such that the opening of the pocket extends into the margin (the pocket would extend into the area between the inner weld 253 and the weld line 225).



Applicant respectfully submits that the characterization of the Podosek patent in the Office Action is inaccurate in that the opening of the Podosek pocket 229 does NOT extend into the margin. Indeed, by stating that “the pocket would extend into the area between the inner weld 253 and the weld line 225,” it seems to indicate that the Patent Office admits that the pocket does not in fact extend into the margin. It is respectfully submitted that “the area between the inner weld 253 and weld line 225” is actually part of the pocket, not part of a margin.

In addition, it is respectfully submitted that a margin of the Podosek sheet protector may be defined by everything that is left of the weld line 225 (as looking at FIGS. 3A and 3B).

Accordingly, as weld line 225 extends all the way to the top of the panels as shown in the enlargement of Podosek's FIG. 3A shown to the right, it is respectfully submitted that any opening of Podosek's pocket is terminated by the weld line 225 and does NOT extend into a margin.



In summary, it is respectfully submitted that the Podosek patent fails to show or discuss, among other things, the following items:

- a sheet protector with an inner weld line that extends to a location that is short of the top edges of the sheet protector;
- a sheet protector having a pocket with an opening that extends into the a margin; and
- a sheet protector having a pocket with an opening that has a width that is greater than the width of the pocket.

Discussion of the Claims

A number of embodiments are respectively defined by independent claims 1, 15, and 18, with claims 8, 11–13, 16, and 17 respectively depending from claims 1 and 15.

Claim 1

Independent claim 1 recites a sheet protector that includes a sheet of material folded to form front and back panels. The panels are welded together at outer and inner weld lines such that a margin and a pocket with an opening are defined. *The inner weld line extends to a location that is short of the top edges of the panels, such that the opening of the pocket extends into the margin.*

Claim 8 recites that the panels may have a notch; claim 11 recites that the margin may have a reinforcing strip; and claim 13 recites that the margin may have binder holes.

In contrast to the sheet protector of claim 1, the Podosek patent fails to discuss or show a sheet protector with an inner weld line that defines a pocket and that extends to a location that is short of the top edges of a pair of panels. Also in contrast to the sheet protector of claim 1, the Podosek patent fails to discuss or show a sheet protector having a pocket with an opening that extends in to a margin of the sheet protector.

Accordingly, it is respectfully submitted that the Podosek patent fails to teach or enable each of the claimed elements as arranged in independent claim 1, either expressly or inherently, as interpreted by one of ordinary skill in the art. Accordingly, it is respectfully submitted that the Podosek patent does not anticipate claim 1 and, therefore, that claim 1, as well as claims 8, 11, and 13 depending therefrom, is patentable.

Claim 15

Independent claim 15 sets forth a sheet protector including front and back panels with a pocket and a margin. The pocket has an opening that is substantially orthogonal to the margin. The opening extends into the margin such that *a width of the opening is greater than a width of the pocket*.

Claim 16 sets forth that the panels may be welded together with weld lines, with an inner weld line extending to a location that is short of the top edges of the panels. Claim 17 recites that the inner weld line may extend to a location that is at least about ¼ inch from the top edges of the panels.

In contrast to the sheet protector of claim 15, the Podosek patent fails to discuss or show a sheet protector that has an opening of a pocket that extends into a margin. Also in contrast to the sheet protector of claim 15, the Podosek patent fails to discuss or show a sheet protector that has a pocket with an opening that has a width greater than the width of the pocket.

In addition, in contrast to the sheet protector of claim 16, the Podosek patent fails to discuss or show a sheet protector with an inner weld line that extends to a location that is short of the top edges of the panels. And in contrast to the sheet protector of claim 17, the Podosek patent fails to discuss or show a sheet protector with an inner weld line that extends to a location that is at least about ¼ inch from the top edges of a pair of panels.

Accordingly, it is respectfully submitted that the Podosek patent fails to teach or enable each of the claimed elements as arranged in claims 15–17, either expressly or inherently, as

interpreted by one of ordinary skill in the art. Accordingly, it is respectfully submitted that the Podosek patent does not anticipate claims 15–17 and, therefore, that claim 15–17 is patentable.

Claim 18

Independent claim 18 sets forth a sheet protector with a pocket, a margin, and an opening. The opening has a width and extends along a side of the pocket and into the margin such that *the width of the opening is greater than the width of the pocket*.

In contrast to the sheet protector of claim 18, the Podosek patent fails to discuss or show a sheet protector with a pocket that has an opening that has a width greater than the width of the pocket.

Accordingly, it is respectfully submitted that the Podosek patent fails to teach or enable each of the claimed elements as arranged in independent claim 18, either expressly or inherently, as interpreted by one of ordinary skill in the art. Accordingly, it is respectfully submitted that the Podosek patent does not anticipate claim 18 and, therefore, that claim 18 is patentable.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 9, 14, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,012,866 to Podosek.

Claims 3–7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,012,866 to Podosek in view of U.S. Patent No. 6,019,539 to Lynton.

Applicant traverses these rejections.

Requirements for Obviousness

The Federal Circuit stated in *In re Oeticker* [977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992)], “[i]f examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.” The CCPA interpreted prima facie obviousness in *In re Lintner* [458 F.2d 1013, 173 USPQ 560, 562 (C.C.P.A. 1972)] as follows:

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or other modification.

In *In re Rinehart* [531 F.2d 1048, 189 USPQ 143 147 (C.C.P.A. 1976)], the CCPA added that the prima facie case requires that the teachings of the reference “appear to have suggested the *claimed subject matter*.” In view of these decisions, a prima facie case of obviousness is established when the Patent Office provides:

- a) one or more references
- b) that were available to the inventor and
- c) that teach
- d) a suggestion to combine or modify the references,
- e) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

If any one of these elements is not present, the prima facie case of obviousness is not established. In the instant case, it is respectfully submitted that the cited references, either alone or in any combination, fail to meet these requirements.

The Cited References

U.S. Patent No. 6,012,866 to Podosek is discussed above.

U.S. Patent No. 6,019,539 to Lynton shows and describes a sheet protector 10 including a first sheet 30 and a second sheet 32 having a retaining pocket 54 formed therebetween. Disposed in spaced-apart relation to the retaining pocket 54 is a securement portion 34 formed between a fourth seal line 36 and a fifth seal line 38. Disposed between the retaining pocket 54 and the securement portion 34 is a flexible pocket 44 having an elongated configuration comprising at least two opposing sealed sides 38, 42, an opening 46, and a sealed end 48. (See column 5, line 50, to column 6, line 10; column 7, line 66, to column 8, line 5; and FIG. 1.)

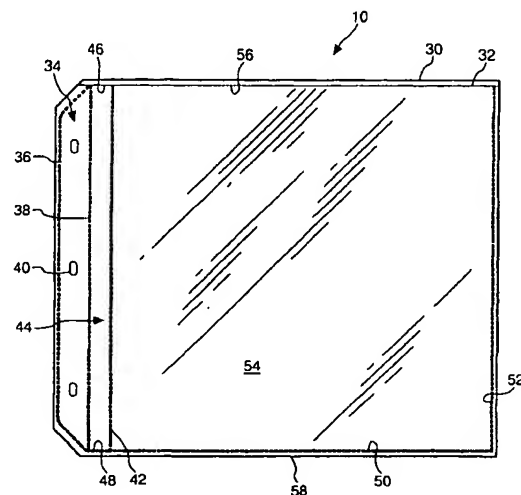


Fig. 1

Similar to the Podosek patent, the Lynton patent fails to show or discuss, among other things, the following items:

- a sheet protector with an inner weld line that extends to a location that is short of the top edges of the sheet protector;
- a sheet protector having a pocket with an opening that extends into the a margin; and
- a sheet protector having a pocket with an opening that has a width that is greater than the width of the pocket.

Discussion of the Claims

Claims 3–7, 9, and 14 depend from claim 1 discussed above, and claim 20 depends from claim 18 discussed above.

Claim 3 recites that the panels of the sheet protector of claim 1 may be welded together along a margin weld line extending from the inner weld line to the outer weld line. Claim 4 sets forth that the margin weld line may intersect the outer weld line at or near a top margin corner of the panels. Claim 5 sets forth that the margin weld line may intersect the outer weld line at a location spaced from the top edges of the panels. Claim 6 recites that the margin weld line may intersect the outer weld line at a location at least about $\frac{1}{4}$ inch from the top edges of the panels. Claim 7 recites that the margin weld line may extend at an angle outwardly from the inner weld line. Claim 9 recites that a size of a notch in a front panel may be smaller than the size of the notch in the back panel. Claim 14 sets forth that the opening of the pocket may have a width that is at least about 2% greater than a width of the pocket. And claim 20 recites that the width of the opening of the pocket of claim 18 may be at least about 2% greater than the width of the pocket.

In contrast to the sheet protectors of claims 3–7, 9, 14, and 20, the respective devices of the Podosek and Lynton patents do not include

- a sheet protector with an inner weld line that extends to a location that is short of the top edges of the sheet protector;
- a sheet protector having a pocket with an opening that extends into the a margin; or
- a sheet protector having a pocket with an opening that has a width that is greater than the width of the pocket.

Accordingly, any combination of the Podosek and Lynton patents fails to teach a suggestion of how to combine or modify the references, the combination or modification of which would

appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Accordingly, it is respectfully submitted that the sheet protectors as set forth in claim 3-7, 9, 14, and 20 would not have been obvious to one having ordinary skill in the art at the time the invention was made in view of the Podosek and Lynton patents, either alone or in combination, and that claims 3-7, 9, 14, and 20 are patentable.

ALLOWABLE CLAIMS

Claims 2, 10, and 19 have been objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims.

Claims 2, 10, and 19 have been rewritten in independent form with the limitations of their respective base claims and any intervening claims. It is respectfully submitted that claims 2, 10, and 19 are in condition for allowance.

CLOSING REMARKS

It is respectfully submitted that the subject application, including claims 1-20, is in condition for allowance. Confirmation of the allowance is respectfully requested.

The Examiner is invited to contact the undersigned at the telephone number below to discuss any issue that may remain, preventing the allowance of the application.

Respectfully submitted,

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